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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/940,035

08/27/2001

Lane W. Lee

M-12040 US

4896

32605

7590

05/11/2006

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EXAMINER

DINH, MINH

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,035

Applicant(s)

LEE ET AL.

Examiner

Minh Dinh

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

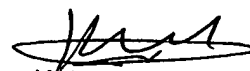
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


KAMBIZ ZAND
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the RCE file 03/30/2006. Claim 25 has been amended.
2. The Applicant has filed a terminal disclaimer to overcome the obviousness-type double patenting rejection. However, the terminal disclaimer is not accepted (see paragraph 5 below for explanation); and the rejection is maintained.

Response to Arguments

3. Applicant's arguments filed 03/30/2006 have been fully considered but they are not persuasive. Applicant states that written support for the limitation "transmitting the secure session key from the host device to the storage engine to authenticate the host" (claim 26, lines 11-12) can be found on page 49, line 4-5. The portion of the specification indicated by the Applicant is associated with figure 15 and is used to describe a recording method. However, claims 25-26 are directed to a method of unlocking files comprising steps to authenticate the host device as described in figures 6 and 18 and associated text.

4. Applicant's arguments, see page 4, last paragraph, filed 03/30/2006, with respect to the rejection(s) of claim(s) 25 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, a discovery of new prior art has necessitated new grounds of rejection. The delay in citation of the newly discovered prior art is regretted.

Terminal Disclaimer

5. The terminal disclaimer filed on 3/30/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 6,636,966 has been reviewed and is NOT accepted. The assignee has not established its ownership interest in the application, in order to support the terminal disclaimer. There is no submission in the record establishing the ownership interest by either (a) providing documentary evidence of a chain of title from the original inventor(s) to the assignee, or (b) specifying (by reel and frame number) where such documentary evidence is recorded in the Office (37 CFR 3.73(b)).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 26, directed to a method of unlocking a locked file, recites the limitation "transmitting the secure session key from the host device to the storage engine to authenticate the host" (lines 11-12). The specification discloses a method of unlocking files comprising steps to authenticate the host device by generating and transmitting the session key to the host device (figures 6, 8, 16-17); however the specification does not disclose that the step of "transmitting the secure session key from the host device to the storage engine to authenticate the host" is performed in the method of unlocking a locked file. Thus, the limitation is not supported by the originally file specification and is considered new matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (7,020,780) in view of Sims, III (6,550,011). Mochizuki discloses a method of unlocking a locked file stored in mastered pre-recorded portion on a storage medium, wherein both a title key and a cipher key are needed to unlock the locked file, the title key and the cipher key being functionally equivalent to a content key and a complement key, the mastered pre-recorded portion including the title key but not the cipher key, the storage medium also having an writeable area that is writable by a storage engine, the method comprising: receiving a request from a host device at the storage engine to unlock the locked file; providing the storage engine with the cipher key; and writing the cipher key to the writeable area to unlock the file (figures 6-7, 9 and associated text). Mochizuki does not disclose authenticating a host device and authenticating the storage engine with a server (Abstract; col. 8, lines 50-66; col. 10, line 26 – col. 11, line 17). Sims discloses a method of unlocking locked content stored in a

storage medium including the steps of authenticating a host device (col. 5, lines 39-59; col. 19, lines 29-49) and authenticating the storage engine with a server (col. 17, lines 1-23). It would have been obvious to modify the Mochizuki method to authenticate the host device and authenticate the storage engine with a server, as taught by Sims, in order to verify that the host device and the storage engine are both authorized devices.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki in view of Sims as applied to claim 25 above, and further in view of Menezes et al ("Handbook of Applied Cryptography"). Sims discloses authenticating the host device requiring two passes (i.e., two messages to be transmitted), but Sims does not disclose using one-pass protocol in which a first entity who generates the random session key is also the entity that encrypts the session key with a second entity's public key and transmits the encrypted session key to the second entity participating in a communication session. Menezes discloses using one-pass protocol for transporting a session key and for implicit key authentication (Section 12.5.1, page 507-508). It would have been obvious to modify the combined method of Mochizuki and Sims to authenticate the host device using one-pass protocol, as taught by Menezes, in order to reduce network traffic.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claim 25 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of U.S. Patent No. 6,636,966 in view of Sims, III (6,550,011). Claim 9 of the patent '966 discloses the same limitations as claim 24 of the present application with two exceptions: (a) authenticating a host device; and (b) receiving a request from the host device at the storage engine to unlock the locked file.

Sims discloses a method of unlocking locked content stored in a storage medium including the step of authenticating a host device (col. 5,

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lines 39-59; col. 19, lines 29-49). It would have been obvious to modify the method of claim 9 ('966) to include the step of authenticating a host device, as taught by Sims, in order to verify that the host device is an authorized device.

Although claim 9 of patent '966 does not disclose receiving a request from the host device at the storage engine to unlock the locked file, this step is deemed to be inherent because it is the storage engine that communicates with the key server regarding the content key to unlock a certain file when the host device simply serves as a conduit for passing the messages between the storage engine and the key server (col. 6, lines 40-61).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,357,005 to Devaux et al.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dinh whose telephone number is 571-272-3802. The examiner can normally be reached on Mon-Fri: 10:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MD

Minh Dinh
Examiner
Art Unit 2132


KAMBIZ ZAND
PRIMARY EXAMINER

MD
5/8/06